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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,953	05/04/2005	Hiroshi Kawato	271725US0PCT	9608
22850	7590	08/22/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			08/22/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/533,953	<b>Applicant(s)</b> KAWATO ET AL.	
	<b>Examiner</b> Sanza L. McClendon	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Amendment received on May 14, 2008, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claim 4. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 1-13 have been overcome by the amendment and has hereby been withdrawn for consideration. Regarding the Hiew et al and Long et al patents, applicant is correct the wrong patent numbers were cited—transposed numbers. Therefore, the correct patent number for Hiew et al and Long et al will be cited on the attached PTO-892 form.

### ***Response to Arguments***

2. Applicant's arguments, see Remarks/Amendment, filed May 14, 2005, with respect to claims 1-13 have been fully considered and are persuasive. The rejection of claims 11-13 under 35 USC 103(a) as being unpatentable over Hiew et al (US 6,695,906) has been withdrawn. Hiew et al fails to teach a coated titanium oxide particle containing alkali metal cations that can be extracted to "pure water" and alkaline-earth metal cations that can be extracted to "pure water" in a total amount of 120 mass ppm or lower.

3. The rejection of claims 11-12 under 35 USC 103(a) as being unpatentable over Werner (GB 1,179,171) has been withdrawn. Werner et al fails to teach a coated titanium oxide particle containing alkali metal cations that can be extracted to "pure water" and alkaline-earth metal cations that can be extracted to "pure water" in a total amount of 120 mass ppm or lower.

4. The rejection of claims 11-12 under 35 USC 103(a) as being unpatentable over Long et al (US 3,329,484) has been withdrawn. Werner et al fails to teach a coated titanium oxide particle containing alkali metal cations that can be extracted to "pure water" and alkaline-earth metal cations that can be extracted to "pure water" in a total amount of 120 mass ppm or lower.

5. The rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Kawa et al (2005/0170180) has been withdrawn. The Kawa et al fails to teach a coated titanium oxide particle containing alkali metal cations that can be extracted to "pure water" and alkaline-earth metal cations that can be extracted to "pure water" in a total amount of 120 mass ppm or lower.

And Kawa et al fails to teach a coated titanium particle containing 80 to less than 97 mass% of titanium oxide.

6. It is deemed the use of term "pure water," without specifying degree of purity, render application so vague and indefinite that one could not practice invention without undue experimentation. Please find a new 112, 2<sup>nd</sup> paragraph rejection below.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The term "pure water" in claims 1 and 11 are deemed to be relative terms which render the claim indefinite. The term "pure water" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no disclosure of the degree of purity. It is unclear if one of ordinary skill in that art would be able to use/make the claimed invention without undue experimentation.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner,

Art Unit 1796

SMc